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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,804	12/22/2000	Jennifer L. Hillman	PF-0576-1 DIV	5165

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EXAMINER

HUTSON, RICHARD G

ART UNIT PAPER NUMBER

1652

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/747,804

Applicant(s)

HILLMAN ET AL.

Examiner

Richard G Hutson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/4/202.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) 6,15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 13 is/are rejected.
- 7) ☒ Claim(s) 2,4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicants cancellation of claims 3-5, 7-12 and 17-20, amendment of claims 1, 2, 13 and 14, Paper No. 1011/4/2002, is acknowledged. Claims 1, 2, 6, and 13-16 are still at issue and are present for examination.

### ***Election/Restrictions***

Applicant's affirmation of the previous election with traverse of Group I, Claims 1, 2, 13 and 14 in Paper No. 6 is acknowledged. Applicants comments regarding the rejoinder of claims 6, 15 and 16 upon allowance of product claims 1, 2, 13 and 14, are acknowledged.

Claims 6, 15 and 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 3.

### ***Information Disclosure Statement***

Applicants filing of information disclosure filed 3/8/2001, is acknowledged. Those references considered have been initialed.

### ***Claim Objections***

Claims 2 and 14 are objected to because of the following informalities:

Claims 2 and 14 are dependent on rejected claim 1.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 13 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection is stated in the previous office action.

Applicants have amended claims 1 and 13 and traverse the rejection on the following basis that the specification provides an adequate written description of the claimed "variants" and fragments of SEQ ID NO: 1. Applicants argue that SEQ ID NO: 1 is specifically disclosed in the application and that polypeptide variants having at least 90% identity to SEQ ID NO: 1 are described and that given a naturally occurring polypeptide sequence, it would be routine for one of skill in the art to recognize whether it was a variant of SEQ ID NO: 1. Herein lies applicants problem. Applicants argue that given a naturally occurring polypeptide sequence, one would be able to recognize whether it was a variant of SEQ ID NO: 1. This is not found persuasive because the question is not whether one would be able to determine whether a given naturally occurring polypeptide is a variant of SEQ ID NO: 1, but rather was the applicant in

possession of said naturally occurring polypeptide variants of SEQ ID NO: 1, such that applicants have adequately described said naturally occurring variants.

Applicants argue that the present claims specifically define the claimed genus through the recitation of chemical structure based on their relationship to SEQ ID NO: 1, however applicants do not define in any way the claimed genus of those naturally occurring amino acid sequences with the claimed chemical structure.

Applicants argue that the present claims do not define a genus which is "highly variant" and present the reference Brenner et al. (PNAS Vol 95: 6073-6078, 1998) in support of this position. Applicants submit that Brenner et al. have determined that 30% identity is a reliable threshold for establishing evolutionary homology between two sequences aligned over at least 150 residues. And therefore "naturally occurring molecules" may exist which could be characterized as human prostate carcinoma tumor antigen-1 or galectin proteins and which have as little as 30% identity over a region of at least 150 residues of SEQ ID NO: 1. While it may be that an evolutionary relationship may exist between two molecules with as little as 30% identity over a region of at least 150 residues, this does not in any way reflect on the description of those naturally occurring molecules or whether a single species is representative of the claimed naturally occurring molecules.

Applicants further argue that the state of the art at the time of the present invention is further advanced than at the time of the *Lilly* and *Fiers* applications and the written description decisions based on these cases. Applicants submit that based on the developments in the field of recombinant DNA technology since these decisions,

one of skill in the art would recognize that given the sequence information of SEQ ID NO: 1 and the additional extensive detail provided by the subject application, the present inventors were in possession of the claimed polypeptide variants. These arguments are not found persuasive.

The Court of Appeals for the Federal Circuit has recently held that a "written description of an invention involving a chemical genus, like a description of a chemical species, 'requires a precise definition, such as be structure, formula [or] chemical name,' of the claimed subject matter sufficient to distinguish it from other materials." *University of California v. Eli Lilly and Co.*, 1997 U.S. App. LEXIS 18221, at \*23, quoting *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993) (bracketed material in original). To fully describe a genus of genetic material, which is a chemical compound, applicants must (1) fully describe at least one species of the claimed genus sufficient to represent said genus whereby a skilled artisan, in view of the prior art, could predict the structure of other species encompassed by the claimed genus and (2) identify the common characteristics of the claimed molecules, e.g., structure, physical and/or chemical characteristics, functional characteristics when coupled with a known or disclosed correlation between function and structure, or a combination of these.

In the instant specification, a single polypeptide comprising SEQ ID NO: 1 is fully described in the form of SEQ ID NO:1, wherein the polypeptide has extracellular adhesion activity. Those sequences that are "naturally occurring" are a subset of this genus. The specification does not adequately describe this subset according to its structure so that one of skill in the art would be able to predict naturally occurring

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sequences, particularly in view of the larger genus that includes both naturally and "manufactured" sequences. Therefore, the instant claims are not adequately described.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at [www.uspto.gov](http://www.uspto.gov).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read 'Richard Hutson', with a long horizontal line extending to the right.

Richard Hutson, Ph.D.  
Patent Examiner  
Art Unit 1652  
January 23, 2003